

REMARKS

This response is submitted in response to the Office Action dated July 7, 2003, and respectfully requests that the Examiner reconsider the rejection of the claims as set forth therein.

In the CPA filed on April 7, 2003, the applicant requested entry of the unentered amendment filed on March 13, 2003. The current Office Action is in response to the previously unentered amendment.

The applicant amended claims 1 and 10 to recite the limitation -- simultaneous display-- of the first and second display attributes.

Specifically, claim 1 was amended to add the limitation -- displaying simultaneously said new message on said display unit in a second display attribute different from said first display attribute--.

Claim 10 was amended to add the limitation -- for displaying a new [messages] message simultaneously on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages--.

The applicant cited support for the amendments to claims 1 and 10 in the specification, page 11, line 21, to page 12, line 6; which discloses the following:

“If the latest message is received during the reading of the message #m (104), the display of message #m is interrupted and the latest message is displayed. *The latest message (105) is displayed in a*

color inversion so that the latest message can be distinguished from the messages which the user has viewed until then. Thus, the latest message is displayed in a display attribute different from that of the messages which the user has viewed until then. The latest message may be displayed in a highlighted display or in boldface display or by way of varying the typeface.”

The applicant maintained that the foregoing paragraph implicitly discloses simultaneous display of the stored messages with the new messages, with new messages having a different display attribute. Therefore, no new matter was added.

35 U.S.C. 112, First Paragraph: Claims 1-18

The Examiner has now rejected claims 1-18 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner asserts that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner asserts that support for the limitation to simultaneously display could not be found in the specification as originally filed.

The Examiner acknowledges that the applicant pointed to support in the specification for the limitation to simultaneously display the old and new messages, but the Examiner asserts that the sentence: “The latest message (105) is displayed in a color inversion so that the latest message can be distinguished from the messages which the user has viewed until then” implies that the view of the old

message is no longer presented and therefore, support for the simultaneous display is lacking.

In response, the applicant disagrees with the Examiner's interpretation and the applicant maintains that further support for "simultaneous" is provided by page 19, line 21, to page 20, line 17. In particular, page 19, lines 24-26, disclose in part: "...the latest message is *firstly displayed* on the display section 8 as shown in Fig. 3...". Also, page 20, lines 7-12, disclose: "Therefore, even if the latest message is received while the user reads the messages, *the latest message is displayed on the display section 8 so as to be distinguishable from other messages*, under the control performed by the control section 4..."

As a result, the applicant maintains that since the latest message is displayed on the display section 8 so as to be distinguishable from other messages, support for the simultaneous display of said new message on said display unit in a second display attribute different from said first display attribute, as recited by claim 1, and analogously recited by claim 10, is found in the specification.

Consequently, the applicant respectfully requests that the Examiner withdraw the rejections of claims 1 and 10 under 35 U.S.C. 112, first paragraph.

35 U.S.C. 103(a) Rejections: Claims 1-18

The Examiner now rejects claims 1, 2, 10 and 11 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett et al (US 5,965,569 – filed March 14, 1989 – issued October 23, 1990), **Amma and** either Sone (US 5,793,304 – filed July 16, 1996 – issued August 11, 1998) or Burgan et al (US 6,166,621 – filed January 29, 1998 – issued December 26, 2000) or McLaughlin et al. (US

4,975,694 – filed March 14, 1989 – issued December 4, 1990). The Bennett et al, Sone, Burgan et al, and McLaughlin et al references were cited previously in the Final Rejection of January 8, 2003.

The rejections over the prior art are essentially identical to those presented in the Final Rejection. The only difference is that the Examiner now cites a new reference, Amma, (US 6,400,256 B2 - filed May 29, 1998 - issued June 4, 2002).

That is, the Examiner repeats the basis for the rejection but adds that in an analogous art, Amma FIG. 9 and the corresponding description in column 5, line 62, to column 6, line 2, show and disclose the simultaneous display of old stored messages and newly received messages.

The Examiner now rejects claims 3 and 12 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett, **Amma and** Sone, Burgan et al and McLaughlin et al and further in view of Fennell (US 5,430,436 – filed July 22, 1994 – issued July 4, 1995). The grounds of rejection are otherwise identical to those presented in the Final Rejection.

The Examiner now rejects claims 4-9 and 13-18 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett, **Amma and** Sone, Burgan et al and McLaughlin et al and further in view of Nakajima (US 4,477,807 – filed June 4, 1982 – issued October 16, 1984). Similarly, the grounds of rejection are otherwise identical to those presented in the Final Rejection.

The Examiner also discusses the prior art rejections in the Response to Arguments. The applicant had argued that neither Bennett nor Sone nor Burgan nor McLaughlin, taken alone or in combination, disclose, teach or suggest

appearance on the display unit of a first display attribute for the stored messages and of a second display attribute for the new messages, when said new message is received by said message receiving unit during the display of said messages, as recited by claims 1 and 10.

The Examiner maintains the same position that Bennett is cited for providing an indication to the user that the new message received during the display mode is not a previously stored message. The Examiner again cites FIGS. 9A, 9B, 10A, 10B and their corresponding description in column 17, lines 29-36, lines 60-63. In particular, the Examiner cites elements 356 and 364 of FIG. 12A which disclose "Activate Unread Message Indicator".

The Examiner asserts that the other references are cited for teaching or suggesting using first and second display attributes to provide different indications to the user.

In response, since the U.S. filing date of Amma is May 29, 1998, the applicant hereby moves to remove Amma as a prior art reference by perfecting a claim to foreign priority under 35 U.S.C. 119(a)-(d) by showing that the present invention of Koga was filed in Japan on February 18, 1998 based on the accompanying certified translation of the foreign priority document. The certified translation of the foreign priority document was performed by Minoru Kudoh of Tokyo, Japan on September 24, 2003.

As a result of the removal of Amma as a prior art reference, claims 1, 2, 10 and 11 patentably distinguish over Bennett et al and either Sone or Burgan et al or McLaughlin et al taken alone or in combination.

Similarly, claims 3 and 12 patentably distinguish over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Fennell, taken alone or in combination.

Finally, claims 4-9 and 13-18 patentably distinguish over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Nakajima, taken alone or in combination.

The foregoing Remarks establish the patentable nature of all of the claims in the application, i.e., claims 1-18. No new matter has been added. It is respectfully submitted that this application is in condition for allowance.

Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Anthony N. Fresco
Registration No. 45,784

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343/4366 FAX

ANF:yd

Enclosure: Certified translation of foreign priority document